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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/037,318

11/07/2001

Erik Leonard Hoffman

05032-00011

4521

22907 7590 09/30/2008

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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

09/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/037,318	<b>Applicant(s)</b> HOFFMAN, ERIK LEONARD	
	<b>Examiner</b> DAVID COMSTOCK	<b>Art Unit</b> 3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23,25-33,37,45-51,55,56 and 73-78 is/are pending in the application.
- 4a) Of the above claim(s) 1-23,25-33,37,45-50,55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51 and 73-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 June 2008 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the pertinent portion of the fourth paragraph of 35 U.S.C. 112:

“...a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.”

Claims 73-78 are rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claims 73-78 are improper hybrid claims. Claims 73-78 recite an apparatus, while claim 51, from which these claims depend, is directed to a method. As such, claims 73-78 place no further limitations on a method or the steps of the method of parent claim 51, but rather are directed to a separate statutory class of invention. Moreover, it is unclear whether claims 73-78 should be treated as method claims or apparatus claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 51 and 73-78, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Masini (5,571,203).

Masini discloses a method for fastening an implant 442 on a femur comprising a step of sawing off the femur head and a part of the neck, such that a part of the neck is maintained. (N.B.: portions of a femoral neck begin immediately above the lesser trochanter; therefore, as clearly seen in, e.g. Figs. 2-4, a portion of the neck is in fact preserved and forms part of an abutment surface. See also, col. 6, lines 35-65). The resulting abutment surface extends at an angle of 90 with respect to a load axis of a femur, such that in a normal upright position of the femur the abutment surface extends substantially horizontal (as set forth in claim 51). A pin, e.g. 312, of a fastening element is driven into the cut and reamed bone such that a supporting element 228 of the device lies against the abutment surface. The fastening element is cemented in place. Masini does not explicitly recite the angle of the pin of between 125 and 145 degrees; however, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have installed provided the pin of the device at an angle in a range between

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about 125 degrees and 145 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges, here, for example, to accommodate the differing condition and/or anatomy of individual patients, involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Response to Arguments***

Applicant's arguments in the response filed 25 June 2008, with respect to the amended claims, have been considered but are not persuasive.

It is first noted that Applicant did not address the outstanding rejection. Applicant states in the Remarks, at lines 6-8: "Claims 51 and 73-78 are *Novel* over Masini" (emphasis added by Examiner) and "Claims 51 and 73-78 have [sic] rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent No. 5,571,203 to Masini ("Masini")." However, the outstanding rejection is based on obviousness and 35 U.S.C. 103(a) not novelty and 35 U.S.C. 102(b). Moreover, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant appears to simply list the limitations of the claims and then summarily conclude that the limitations are not shown in the reference. It is unclear how Masini could *not* be seen as having an abutment surface that extends at an angle of 90 degrees with respect to a load axis of the femur, such that in the normal upright position of the femur the abutment surface extends substantially horizontal, as set forth in the amended claims. Indeed, this is

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precisely what is clearly shown on the first page and the referenced portions of the Masini patent. Regarding the angle of the pin, again, the rejection was previously and is still based on obviousness and 35 U.S.C. 103(a), not on anticipation and 35 U.S.C. 102(b).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733